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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,394	12/14/2005	Kazumi Okuro	Q90173	9016

23373 7590 02/27/2007

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EXAMINER	
LOEWE, SUN JAE Y	
ART UNIT	PAPER NUMBER
1609	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,394	OKURO ET AL.	
	Examiner	Art Unit	
	Sun Jae Y. Loewe	1609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-57* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a 371 national stage application of PCT/JP04/05465. Claims 1-57 are currently pending in the instant application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-12 drawn to products of Formula 1. Applicant is further required to elect a single species of Formula 1.

Group II, claim(s) 13-25 drawn to process of making products of Formula 5, using starting material of Formula 2. Applicant is further required to elect a single species of Formula 3, which is a claimed intermediate in the synthetic process.

Group III, claim(s) 26-31 drawn to process of making products of Formula 6, using starting material of Formula 2. Applicant is further required to elect a single species of Formula 6.

Group IV, claim(s) 32-39 drawn to process of making products of Formula 3, using starting material of Formula 6. Applicant is further required to elect a single species of Formula 6.

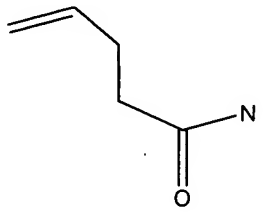
Group V, claim(s) 40-45 drawn to process of making products of Formula 3, using starting material of Formula 2. Applicant if further required to elect a single species of Formula 3.

Group VI, claim(s) 46-48 drawn to process of making products of Formula 8, using starting material of Formula 7. Applicant if further required to elect a single species of Formula 7.

Group VII, claim(s) 49-57 drawn to process of making products of Formula 5, using starting material of Formula 4.

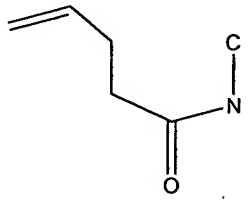
The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reason.

The technical feature linking the claims is a core with the general structure (note, valences were intentionally left incomplete for positions that have variable substituents):



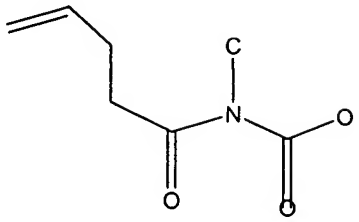
Compounds that fit this formula are taught in the prior art, for example, 2-(2-methylethyl)-4-penteneamide (Bock et al., published in 1971). Therefore, the product linking the claims does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, Groups I-VII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

It is noted that compounds of Formulas 1 do not constitute a proper Markush group as defined in MPEP § 1850.III.B. The compounds do not share a significant structural element that has a common function. The common core for these compounds has the following structure (note, valences were intentionally left incomplete for positions that have variable substituents):



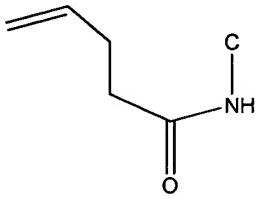
Compounds that fit this formula are taught in the prior art, for example, N-(aminocarbonyl)-2-(1-methylethyl)-4-pentenamide (Ohtsuji, published in 1996).

It is noted that compounds of Formulas 3 do not constitute a proper Markush group as defined in MPEP § 1850.III.B. The compounds do not share a significant structural element that has a common function. The common core for these compounds has the following structure (note, valences were intentionally left incomplete for positions that have variable substituents):



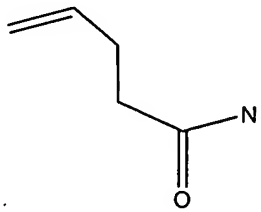
Compounds that fit this formula are taught in the prior art (eg. Carbamic acid, (1-oxo-4-pentenyl) (phenylmethyl)-, phenylmethyl ester, Suh et al., published in 2002).

It is noted that compounds of Formulas 6 do not constitute a proper Markush group as defined in MPEP § 1850.III.B. The compounds do not share a significant structural element that has a common function. The common core for these compounds has the following structure (note, valences were intentionally left incomplete for positions that have variable substituents):



Compounds that fit this formula are taught in the prior art (eg. N-[N-(5-amino-5-carboxy-1-oxopentyl)-4,5-didehydro-L-norvalyl], Baldwin et al., published in 1994).

It is noted that compounds of Formulas 7 do not constitute a proper Markush group as defined in MPEP § 1850.III.B. The compounds do not share a significant structural element that has a common function. The common core for these compounds has the following structure (note, valences were intentionally left incomplete for positions that have variable substituents):



Compounds that fit this formula are taught in the prior art (eg, N-(aminocarbonyl)-2-(1-methylethyl)-4-pentenamide (Ohtsuji, published in 1996).

Applicant is advised that for the reply to this requirement to be complete it must include (i) an election of one of Groups I-VII to be examined, although the requirement may be traversed (37 CFR 1.143), (ii) election of a single compound, (iii) identification of a subgenus of species with a common core, that includes the elected compound, to be examined, (iv) identification of support in the written description for the identified subgenus, (v) identification of the claims readable on the identified subgenus.

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of the subgenus claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed subgenus claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074. The examiner can normally be reached Monday through Friday 7:30AM to 5:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisors, Cecilia Tsang (571) 272-0562, can be reached. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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